

### **REMARKS**

In the Advisory Action dated July 8, 2003, the Examiner acknowledged the Amendment after final, but did not enter the amendments to the claims and maintained the rejections of record even though, as the Examiner stated, the proposed amendment would have overcome the rejections. The Examiner asserted that the proposed claim language "comprising" would necessitate further search and new rejections of proteins comprising recited sequences. As such, Applicant files the present submission.

Claims 1-20 were filed in this case. Of these, claims 14-18 have been cancelled without prejudice for later presentation in this or related cases. Claims 1-13 and 19-23 are rejected, and claim 13 is objected to. Thus, claims 1-13, and 19-23 are pending.

This response addresses those issues raised in the Advisory Action. It is believed that the present amendment renders all pending claims allowable.

### **THE EXAMINER'S ACTION**

In the Advisory Action dated July 8, 2003, the Examiner:

rejected claims 1-11, 13, 19, and 20-23 under U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention;

rejected claim 12 under 35 U.S.C. § 102(b) as being anticipated by WO8909787;

rejected claim 13 under the judicially created doctrine of obviousness-type double patenting; and

objected to the recitation of sequences for SEQ ID NOS. 47, 49, and 53 in claim 13.

### **REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Office has rejected claims 1-11, 13, 19, and 20-23 under U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. Claims 1, 13, and 19-23 have been amended to recite a peptide "comprising" or "comprises" a particular SEQ ID rather than "corresponding to."

In light of the amendments, one of ordinary skill in the art would be apprised of the scope of the invention and therefore the rejection should be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Office has rejected claim 12 under 35 U.S.C. § 102(b) as being anticipated by WO8909787. The Office has taken the position that the reference discloses the peptide VGVVPGIPEP, which contains the sequence VVP, anticipating the claims drawn to the generic formula  $R_1$ -VVP- $R_2$ . While disagreeing with the Office about the anticipatory effect of the reference, Applicant here amends claim 12 to call for a peptide having a formula of  $R_1$ -Valyl-Valyl-Prolyl-Glutyl- $R_2$ . In light of the addition of the glutamine amino acid residue to the formula, the reference fails to disclose every element of claim 12, therefore the rejection should be withdrawn.

#### **DOUBLE PATENTING REJECTION**

The Office has rejected claim 13 under obviousness type double patenting as being unpatentable over claims 1-11 and 27 of U.S. Patent No. 6,069,129, which claims recited SEQ ID No 17 (VVPQ). The Office asserts that the only difference between SEQ ID No 17 and SEQ ID Nos 42 and 43 in the instant application is that SEQ ID No 42 and SEQ ID No 43 have protective groups at either the N and/or C termini. The Office has taken the position that such a substitution is obvious because it is well known in the art that such substitutions increase solubility and/or stability for pharmaceutical applications.

Although Applicant strongly disagrees with the Examiners position, a terminal disclaimer over U.S. Patent No. 6,069,129 and the appropriate fee under 37 C.F.R. § 1.20(d) is submitted herewith. As such, Applicant believes the rejection has been overcome.

#### **CLAIM OBJECTIONS**

The Office objected to the recitation of sequences for SEQ ID Nos. 47, 49, and 53 in claim 13 as being erroneous. The sequence recitations of SEQ ID Nos. 47, 49, and 53 in claim 13 have been amended to correctly recite two valine residues. In addition, claim 23 has also

been amended to correctly recite two valine residues in SEQ ID No. 53. As such, the objection is believed to be overcome.

### CONCLUSION

In view of the amendments to the claims and the remarks presented herein, it is submitted that the present application is in condition for final allowance and notice to such effect is requested.

Respectfully submitted,

Dated: 8/14/03

By 

W. Scott Harders  
Reg. No. 42,629

N. Nicole Endejann  
Reg. No. 50,229

BENESCH, FRIEDLANDER,  
COPLAN & ARONOFF LLP  
2300 BP Tower  
200 Public Square  
Cleveland, Ohio 44114  
(216) 363-4504